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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,474	05/15/2001	Yoshimichi Yamanaka	010611	8058

23850 7590 05/20/2003

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

15

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/854,474		YAMANAKA, YOSHIMICHI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Christopher M. Keehan		1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12, 14</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Specification***

The objection to the disclosure is has been withdrawn due to applicant's amendments.

#### ***Claim Objections***

The objection to claims 13, 14, and 18-21 has been withdrawn due to applicant's amendments.

#### ***Claim Rejections - 35 USC § 103***

The rejection of claims 13-22 under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (6,451,439 B2) has been withdrawn in light of a new grounds of rejection.

The rejection of claims 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over DeLouise et al. (6,273,985 B1) has been withdrawn due to applicant's arguments.

#### ***Discussion of "X" References***

The following documents were cited on an international search report as "X" references concerning the instant application: JP 2000-073010A, EP 0984034A, EP 0982359A, JP 10-204222A, and JP 2000-086990A. As there was a restriction requirement for this case, the EP documents cited claims that were non-elected by

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applicant; JP 10-204222A was not cited for claims that were elected. The remaining JP documents were applied as set forth below.

***New Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13, 15, and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Murase et al. (JP 2000-086990, machine translation). The examiner is relying on the attached machine translation for this document. Murase et al. disclose a bonding method comprising coating a primer composition comprising a silane coupling agent on a substrate (section 0005), applying a curable composition comprising a hydrocarbon polymer having at least one alkenyl group per molecule onto the primed substrate, and curing the curable composition to obtain the cured product bonded to the substrate (section 0012).

Regarding claim 15, Murase et al. disclose the instantly claimed polyisobutylene (section 0012).

Regarding claim 18, Murase et al. disclose wherein the primer composition comprises a polyvalent alkoxysilane or condensation product thereof (section 0005).

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Regarding claims 19 and 20, Murase et al. disclose wherein the primer composition comprises an organotitanium compound and a hydrosilylation catalyst (section 0009).

Regarding claim 21, Murase et al. disclose wherein the primer composition comprises an organic solvent (section 0005).

Regarding claim 22, Murase et al. disclose the primer composition providing firm adhesion between various substrates and cured materials, which results in a laminate (section 0012).

Claims 13, 15, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiina et al. (JP 2000-073010, machine translation). The examiner is relying on the attached machine translation for this document. Shiina et al. disclose a bonding method comprising coating a primer composition comprising a silane coupling agent on a substrate, applying a curable composition comprising a hydrocarbon polymer having at least one alkenyl group per molecule onto the primed substrate, and curing the curable composition to obtain the cured product bonded to the substrate (section 0004).

Regarding claim 15, Shiina et al. disclose the instantly claimed polyisobutylene (section 0004).

Regarding claims 19 and 20, Shiina et al. disclose wherein the primer composition comprises an organotitanium compound and a hydrosilylation catalyst (section 0007).

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Regarding claim 21, Shiina et al. disclose wherein the primer composition comprises an organic solvent (section 0008).

Regarding claim 22, Shiina et al. disclose the primer composition providing firm adhesion between various substrates and cured materials, which results in a laminate (section 0013).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Okamoto et al. (6,451,439 B2). Regarding claims 13-15, Okamoto et al. disclose a bonding method for bonding a cured product to a substrate comprising coating a primer composition comprising a silane coupling agent, specifically those as instantly claimed (col.7, line 52-col.8, line 55) on a substrate (Abstract), applying a curable composition comprising hydrocarbon polymer, more specifically polyisobutylene as instantly claimed (Example 6), and curing the composition (Example 6).

Regarding claims 16 and 17, Okamoto et al. disclose wherein the curable composition has a curing agent containing two or more silicon-bound hydrogen atoms

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per molecule, and wherein the curing agent is a polyorganohydrogen polysiloxane containing two or more hydrosilyl groups per molecule (col.2, lines 48-59).

Regarding claim 18, Okamoto et al. disclose wherein the composition can comprise a polyvalent alkoxysilane and/or a condensation product thereof (col.2, lines 48-59).

Regarding claim 19, Okamoto et al. disclose an organoaluminum compound and/or an organotitanium compound (col.8, line 66-col.10, line 15).

Regarding claim 20, Okamoto et al. disclose a hydrosilylation catalyst (col.11, line 41-col.12, lines 4).

Regarding claim 21, Okamoto et al. disclose an organic solvent (col.12, lines 16-31).

Regarding claim 22, Okamoto et al. disclose the primer composition providing firm adhesion between various substrates and cured materials, which results in a laminate (Example 6).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers

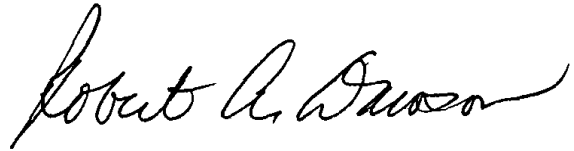
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for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan

May 1, 2003

A handwritten signature in black ink, appearing to read "Robert A. Dawson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700